

**Remarks**

This Application has been carefully reviewed in light of the final Office Action mailed March 19, 2003. Applicants appreciate the Examiner's consideration of the Application. Although Applicants believe all pending claims are allowable over the prior art without amendment, to expedite issuance of this Application, Applicants have made clarifying amendments to Claims 1, 7-10, 13-24, 28-31, and 36-39 and respectfully provide the following additional remarks. None of these changes is considered necessary for patentability. Applicants respectfully request reconsideration and allowance of all pending claims.

**The Claims are Allowable over *Henson***

The Examiner rejects Claims 1-4 and 6-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,167,383 to *Henson* in view of Applicants' Disclosure, in view of U.S. Patent 6,009,046 to Nick ("*Nick*"), and further in view of Official Notice. Applicants respectfully disagree.

*Henson* indeed discloses selection of an option limiting later selections of options -- i.e. the "ripple effect" the Examiner mentions. (Final Office Action, Page 2). However, *Henson* does not disclose, teach, or suggest at least (1) "**during the configuration session, for each of the series of selection option sets, receiving data from an available-to-promise engine regarding the one or more items in the selection option set,**" (2) "**during the configuration session, for each of the series of selection option sets, dynamically applying an optimization function with respect to each item in the selection option set according to the data received from the available-to-promise engine during the configuration session to identify an item of the selection option set as a default selection, the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function,**" and (3) "**providing for presentation to the user the series of selection option sets, each selection option set comprising its identified default selection,**" as recited in Applicants' independent Claim 1 as amended (and similarly in Applicants' other independent claims as amended).

The Examiner states that "the optimization function is inherent in the calculations made to reconfigure the product and the price changes associated with this reconfiguration would be considered an optimization, since if the [price] changes were not made then the manufacturer would have to absorb the cost." (Final Office Action, Pages 2-3). Applicants respectfully disagree. In the system disclosed in *Henson*, selection of any option may alter the configuration of the product and therefore change its cost. For example, if a current configuration including a \$100 hard drive is priced at \$1000, then naturally if a \$200 hard drive is selected the altered configuration may reflect the increased cost of the hard drive and be priced at \$1100. Each option has a cost and the total price of the configuration simply reflects the cost of all the options within it. However, this involves no "optimization function" as recited in Applicants' independent claims. Indeed, in the previous Office Action the Examiner stated explicitly that *Henson* is "silent regarding an optimization function that minimizes prices or maximizes profits" (November 14, 2002 Office Action, Page 4), such as are recited in Applicants' dependent Claims 6 and 4, respectively, as particular examples of the "optimization function" recited in Applicants' independent Claim 1.

Even if the Examiner was correct in stating that "the optimization function is inherent in the calculations made to reconfigure the product and the price changes associated with this reconfiguration would be considered an optimization" (Final Office Action, Page 2), *Henson* still would provide no disclosure, teaching, or suggestion of, as recited in Applicants' independent Claim 1 as amended (and similarly in Applicants' other independent claims as amended):

- *during the configuration session*
- *for each of the series of selection option sets*
- *dynamically applying an optimization function with respect to each item in the selection option set*
- *according to the data received from the available-to-promise engine during the configuration session*
- *to identify an item of the selection option set as a default selection*
- *the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function*

The Examiner directs Applicants to Figure 5 of *Henson* as showing "what is 'featured' as being the default configuration." (Final Office Action, Page 3) However, neither Figure 5 (the "all option view"), Figure 3 (the "standard view"), nor the remainder of *Henson* disclose, teach, or suggest each "featured" option in each set of configuration options being identified during the configuration session through dynamic application of an optimization function with respect to each option in each set of configuration options according to data received from an available-to-promise engine during the configuration session, as recited in Applicants' independent claims (as opposed to being identified prior to the configuration session through static application of an optimization function according to undisclosed data received prior to the configuration session, as disclosed in *Henson*). Examples of the dynamic nature of the optimization function recited in Applicants' independent Claim 1 as amended are provided in dependent Claims 7-9 as amended, which recite as particular examples defining the optimization function "during the configuration session" (Claim 7), "in response to an identification of the user during the configuration session" (Claim 8), and "in response to a product selection decision made by the user during the configuration session" (Claim 9).

Furthermore, inherency requires that the missing subject matter must *necessarily* be present in the things described in the reference. Extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); M.P.E.P. § 2112. *Henson*, a reference that merely discloses changing the price to reflect changes in the selected configuration, does not incorporate every possible (or even any) optimization function. Thus, the "optimization function" recited in Applicants' independent claims is certainly not inherent in the disclosure of *Henson*.

Applicants respectfully dispute the Examiner's apparent characterization of Applicants' specification. The Examiner states that Applicants' specification discloses that "use and design of optimization functions and ATP[ engines] in determining an optimal configuration is old and

well known in the art," apparently citing Pages 9 and 21 of Applicants' specification. (Final Office Action, Page 3). Page 9, Lines 6-9 of Applicants' specification merely states: "As known in the art, the ATP engine 14 includes a database which identifies all components and subsystems which are currently actually available, and the dates on which they can be shipped." Applicants do not state or otherwise acknowledge in this passage or elsewhere that use of an ATP engine is old and well known in connection with determining an optimal configuration as the Examiner suggests. Page 21, Lines 17-20 of Applicants' specification merely states: "Optimization of a function using alternative choices as described is well within the skill of those skilled in the art, and will not be described in detail" – that is, applying an optimization function to a set of alternatives is well known in the art. Applicants do not state or otherwise acknowledge in this passage or elsewhere that use and design of optimization functions in determining an optimal configuration is old and well known as the Examiner suggests. Collectively, these passages merely acknowledge that standard ATP engines are well known and that generic optimization functions are well known, nothing more. Applicants certainly have not stated or otherwise acknowledged that dynamic application of an optimization function with respect to each option in each set of configuration options according to data received from an available-to-promise engine during the configuration session, as recited in Applicants' independent claims, was generally known to those of ordinary skill in the art at the time of the invention.

With respect to the Examiner's proposed combination of *Henson* with statements from Applicants' specification, *Nick*, and Official Notice, Applicants respectfully submit that the Examiner has not shown anything in *Henson*, *Nick*, or in knowledge generally available to those of ordinary skill in the art at the time of the invention (including the information acknowledged as well known in Applicants' specification) that would have suggested or motivated one of ordinary skill in the art at the time of the invention to combine these references in the manner the Examiner proposes. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis in original). Thus, the mere fact that the teachings of one reference might possibly improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine the references. Nothing in *Henson*, *Nick*, or knowledge generally available to those of ordinary skill in the art at the time of the

invention (including the information acknowledged as well known in Applicants' specification) would have suggested or motivated the proposed combination, nor has the Examiner provided any specific evidence that suggests or motivates the proposed combination.<sup>1</sup>

The Examiner merely asserts in conclusory fashion that it "would be obvious" to include in *Henson* optimization functions as disclosed in Applicants' specification and in *Nick* "because a manufacturing company is always modifying [its] sales strategy, therefore, to better implement the strategy would require an optimization function that dynamically matches the desired outcome of the strategy" (Final Office Action, Page 3) – that is, the combination would have been obvious because it would benefit a manufacturing company. Applicants note that *Henson* was filed on behalf of a well known manufacturing company and describes the features and operation of the company's actual or proposed "online store user interface for enabling custom configuration, pricing, and ordering of a computer system via the Internet," (Column 1, Lines 18-21), yet does not disclose, teach, or suggest the very features and operation the Examiner concludes would be beneficial to the company and therefore obvious. Nor has the Examiner supplied any other prior art references disclosing these features and operation. In any event, Applicants respectfully point out that speculation in hindsight that it "would have been obvious" to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.<sup>2</sup> and governing Federal Circuit case law.<sup>3</sup> Indeed, if such was the

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<sup>1</sup> If "common knowledge" or "well known" art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03. Furthermore, the Examiner does not particularly point out the information of which the Examiner takes Official Notice. If Official Notice is being taken, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03.

<sup>2</sup> See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

<sup>3</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

proper standard for finding obviousness, the patent system would likely cease to exist in any meaningful form.

Even assuming for the sake of argument that *Henson* could be properly combined with *Nick* or with knowledge generally available to those of ordinary skill in the art at the time of the invention (including the information acknowledged as well known in Applicants' specification), the proposed combination still would not disclose, teach, or suggest the limitations specifically recited in Applicants' independent claims discussed above. For example, Applicants' independent Claim 1 as amended (similar to Applicants' other independent claims as amended) recites:

- *during the configuration session*
- *for each of the series of selection option sets*
- *dynamically applying an optimization function with respect to each item in the selection option set*
- *according to the data received from the available-to-promise engine during the configuration session*
- *to identify an item of the selection option set as a default selection*
- *the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function*

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1, 10, 20, 28, and 36 and all claims that depend on these claims.

Applicants' independent Claim 10 further recites "*for each selection option set, before presenting the selection option set to the user, determining which of the items of the selection option set are actually available to the user in accordance with a user-specified date constraint and presenting only those items of the selection option set which are actually available to the*

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175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal

*user in accordance with the user-specified date constraint.*" Similar limitations are recited in Applicants' independent Claim 20 and dependent Claims 2, 31, and 39. *Henson* discloses providing to the user a warning indicator to indicate an option which, if already selected or selected in the future by the user, would represent an invalid configuration or would adversely impact a shipment or delivery date of the configured product. Using the system disclosed in *Henson*, as clearly illustrated in Figure 4, the user is presented with all options and remains free to at least initially select any of these options. Numerous examples from *Henson* demonstrating this distinction were provided in Applicants' previous Response.

Although the Examiner acknowledges that *Henson* does not disclose these limitations, the Examiner again asserts in conclusory fashion that it "would be obvious" to include in *Henson* "allowing a user to specify a date required, because this would allow Henson to eliminate some of the options to the user that have lead-times that exceed the [user's] required delivery data and preclude consideration of those items from the list." (Final Office Action, Pages 3-4). Applicants respectfully submit that the Examiner's reasoning, in addition to being founded on improper hindsight, is circular. Both "a user-specified date constraint" and "presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint" are recited in Applicants' independent Claim 10. Yet the Examiner appears to assert that the first limitation ("a user-specified date constraint") would have been obvious because it would have enabled the second limitation ("presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint"). The Examiner provides no basis for the obviousness determination external to Applicants' claim. Applicants respectfully submit that this reasoning is improper under the M.P.E.P. and governing Federal Circuit case law.

Similarly, the Examiner asserts in conclusory fashion that it "would have been obvious" to include in *Henson* "not presenting a configuration that is not immediately available to a customer that presented criteria that eliminates the configuration as an order option, because this would eliminate choices to the customer of [the] configuration that do not meet a specified

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art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

delivery date and might reduce confusion." (Final Office Action, Page 4). Applicants again respectfully submit that the Examiner's reasoning, in addition to being founded on improper hindsight, is circular. The limitation "presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint" is recited in Applicants' independent Claim 10. The Examiner roughly equates this limitation to "eliminat[ing] choices to the customer of [the] configuration that do not meet a specified delivery date." (Final Office Action, Page 4). Thus, in setting forth the reasoning for the determination of obviousness, the Examiner appears to effectively assert that this limitation would have been obvious because it would allow itself to occur. The Examiner provides no basis for the obviousness determination external to Applicants' claim. The only additional reasoning provided is speculation in hindsight that this limitation "might reduce confusion." (Final Office Action, Page 4). Applicants again respectfully submit that this reasoning is improper under the M.P.E.P. and governing Federal Circuit case law.

Furthermore, Applicants again note that *Henson* was filed on behalf of a well known manufacturing company and describes the features and operation of the company's actual or proposed "online store user interface for enabling custom configuration, pricing, and ordering of a computer system via the Internet," (Column 1, Lines 18-21), yet does not disclose, teach, or suggest the very features and operation the Examiner concludes would be beneficial to the company and therefore obvious. Nor has the Examiner supplied any other prior art references disclosing these features and operation.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 10 and 20, all claims that depend on these claims, and dependent Claims 2, 31, and 39.



**Conclusion**

Applicants have made an earnest attempt to place this Application in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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